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10/780,805	02/18/2004	Brian Gallagher	GALG / 09CO	1497

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EXAMINER

GRAHAM, MARK S

ART UNIT PAPER NUMBER

3711

DATE MAILED: 07/21/2005

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20050712

Application Number: 10/780,805
Filing Date: 2/18/2004
Appellant(s): GALLAGHER

MAILED

JUL 20 2005

Group 3700

Gregory Ahrens
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/2/05.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-10 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

3116926	Owen et al.	1-1964
6,280,353	Brundage	8-2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owen in view of Muhlhausen. This rejection is set forth in prior Office Action, Paper No. 20040527.

Claims 7-10 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 20040527.

(11) Response to Argument

Appellant's first argument is that Owen does not teach the use of a bat less than 2 ¼ inches though Owen does teach down to 2 ¼ inches. The examiner, however, is not asserting that Owen teaches the claimed diameter. Were that the case an anticipation rejection based on Owen would have been applicable.

Owen, as appellant has noted, is a training bat to allow a batter to sharpen his batting skills. One such batting skill, though not addressed by Owen, is hand/eye coordination. However, the prior art in the form of Muhlhausen does address this skill with regard to training bats. Muhlhausen teaches that to practice this skill it is desirable to use a reduced diameter barrel within the range claimed by appellant. The barrel weight and length may be changed as desired depending on the age, height and strength of the batter (Col. 3, lines 10-16) just as these parameters may be varied as needed with Owen's bat. The examiner considers it well within the realm of the

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ordinarily skilled artisan to have reduced the diameter of Owen's bat within the range disclosed by Muhlhausen if it was desired to enhance the training experience by providing for hand/eye coordination training.

As to the length and weight of the bat, the appellant has put no limits on "conventional" thus any useable weight and length may be considered "conventional." Obviously however, if one wishes to develop proper hand eye coordination using the technique taught by Muhlhausen they will want to do so with a bat of "conventional" weight and length such as those disclosed by Owen for the training to be of any benefit all.

Regarding appellant's next argument, no support is given for the proposition that reducing the diameter of Owen's bat does not allow for enough wood for the weight compartment to be accommodated. Applicant's claim 1 with which all of the other claims stand or fall only requires the bat to be less than $2\frac{1}{4}$ inches and removing even a millimeter from a $2\frac{1}{4}$ inch Owen bat as depicted in Fig. 2 would not remove the ability of the bat to hold weights. Moreover, the ordinarily skilled artisan is not presumed to work in a vacuum and if a reduced barrel as taught by Muhlhausen were used with Owen's training bat the skilled artisan would obviously size the weight compartment and weights accordingly and account for the stress load of the material used to fashion the bat barrel.

As to appellant's next argument the Muhlhausen has not been cited to teach removable bat barrels. Muhlhausen has only been cited to teach the efficacy of using a reduced diameter barrel. Therefore there is no requirement to make Owen's barrel

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detachable. Moreover, even if there were Owen already teaches a bat with detachable detachable pieces.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant's final argument concerns claims 7-10. Appellant's reasoning as to why such a rejection is allegedly in error is identical to that presented with regard to claims 1-6 and fails for the same reasons pointed out above. Brundage, as appellant has noted, is a training bat to allow a batter to sharpen his batting skills. One such batting skill, though not addressed by Brundage, is hand/eye coordination. However, the prior art in the form of Muhlhausen does address this skill with regard to training bats. Muhlhausen teaches that to practice this skill it is desirable to use a reduced diameter barrel within the range claimed by appellant. The barrel weight and length may be changed as desired depending on the age, height and strength of the batter (Col. 3, lines 10-16) just as these parameters may be varied as needed with Brundage's bat. The examiner considers it well within the realm of the ordinarily skilled artisan to have reduced the diameter of Brundage's bat within the range disclosed by Muhlhausen

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if it was desired to enhance the training experience by providing for hand/eye coordination training. Again, the appellant has put no limits on "conventional" thus any useable weight and length may be considered "conventional." Obviously however, if one wishes to develop proper hand/eye coordination using the technique taught by Muhlhausen they will want to do so with a bat of "conventional" weight and length for the training to be of any benefit all.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Mark S. Graham

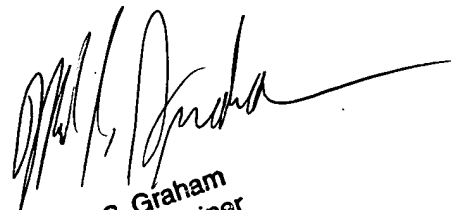
MSG

July 19, 2005

Conferees:


Greg Mdivich


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